

REMARKS

The application was filed on 30 March 2001 with twelve claims. The Examiner examined the application and on 24 March 2005 issued a first Action. In the Examiner's Action, the Examiner rejected claims 5, 6, 8, 9, and 12 under 35 U.S.C. §112, second paragraph. The Examiner also rejected claims 1 and 4 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,765,138 entitled APPARATUS AND METHOD FOR PROVIDING INTERACTIVE EVALUATION OF POTENTIAL VENDORS to Aycock et al. (Aycock '138), claims 2, 3, 7-11 under 35 U.S.C. §103(a) as being unpatentable over Aycock '138; and claims 5, 6 and 12 under 35 U.S.C. §103(a) over Aycock '138 in view of U.S. Patent No. 5,627,973 entitled METHOD AND APPARATUS FOR FACILITATING EVALUATION OF BUSINESS OPPORTUNITIES FOR SUPPLYING GOODS AND/OR SERVICES TO POTENTIAL CUSTOMERS to Armstrong (Armstrong '973). Applicants amended the claims, cancelled claims 10-12 and added claims 13-20.

The Examiner responded on 07 October 2005 by maintaining the rejection of claims 6 and 9 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph. The Examiner further issued new rejections of claims 1-9 and 13-20 under 35 U.S.C. §112, 1<sup>st</sup> paragraph; and 35 U.S.C. §112, 2<sup>nd</sup> paragraph. The Examiner further rejected claims 1-9 and 13-20 under 35 U.S.C. §101 alleging that the invention is directed to non-statutory subject matter, asserting that the claimed invention does not produce a useful, concrete, and tangible result. Applicants amended claims 1, 6, 7, and 9, and removed an abbreviation from the other claims.

The Examiner then issued another Action mailed 03 April 2006 and rejected claims 1-9, 13-20 under 35 U.S.C. §112, 1<sup>st</sup> paragraph; and 35 U.S.C. §112, 2<sup>nd</sup> paragraph. The Examiner maintained the rejection of the claims under 35 U.S.C. §101 alleging that the invention is directed to non-statutory subject matter stating that the claimed invention does not produce a useful, concrete, and tangible result. are pending. The Examiner further rejected claims 1-9 and 13-20 under 35 U.S.C. §103(a) as being unpatentable over Daskalontonakis, Michael K., "ACHIEVING HIGHER SEI LEVELS" IEEE COMPUTER, Vol. 27, No. 7, pp. 17-24, July 1994 (hereinafter referred to as Daskalontonakis) and Paulk, Mark et al., "Capability Maturity Model for Software, Version 1.1, Technical Report CMU/SEI-93-TR-024" SOFTWARE ENGINEERING

INSTITUTE, Carnegie Mellon University, Pittsburgh, Pennsylvania, February 1993 (hereinafter referred to as CMM).

In response, Applicants amend the claims and cancel claim 20; claims 1-9 and 13-19 are pending.

*The Rejection of claims 1-9 and 13-19 under 35 U.S.C. §112, 1<sup>st</sup> ¶*

The Examiner maintains the rejection of claims 1-9 and 13-19 under 35 U.S.C. §112, first paragraph. Specifically the Examiner states that the specification does not describe the claimed subject matter as to enable one skilled in the art to make and use the invention. The Examiner maintains that there is no explanation as to how the results from the matrix and the questions are combined to make recommendations because there are no set guidelines to correlate with evaluation outcome.

Applicants traverse the rejection of the claims under 35 U.S.C. §112, first paragraph because 35 U.S.C. §112, 1<sup>st</sup> ¶ is addressed to whether or not the specification sets forth a written description of the invention in such a manner as to enable one of ordinary skill in the arts of information technology services to make and use the invention, and to set forth the best mode contemplated at the time of the invention. Claims are not rejected under the first paragraph of 35 U.S.C. §112, the specification is rejected.

In response, however, Applicants refer the Examiner to the specification at page 10, line 20 through page 11, line 14, and to figure 4 of Applicants' Drawing which illustrates pertinent questions, and to figure 5 of the Drawing which provides a matrix. At page 11, line 8 of the specification, Applicants state "[t]he answers to the questions will lead the assessment to a determination of the level of maturity as well as identifying areas for improvement." Thus, answers to the questions relating to a service attribute, i.e., answers to the questions shown in Figure 4, in this case the definition and understanding of service, determine the maturity level of that service attribute, i.e., at what column in the matrix of Figure 5, that particular service attribute is perceived by the customer. In particular and as only one example of how the answers to the questions and the results from the matrix can be combined to create recommendations, Applicants direct the Examiner's attention to the specification at page 11, lines 9-12 which

continues the quoted specification above, “[f]or example, if there is a disagreement on the scope of the service between the provider and the customer, it will be hard to have a mature service and the remedy suggested may be that the provider and the customer agree on the scope of the service and document it.” It is difficult to understand how one of ordinary skill in the art could be more enabled: if the answers to the questions indicate that a disparity exists between what the customer perceives and what the provider thinks, then that service attribute will have a maturity level towards the left of the matrix, either ad hoc or perhaps repeatable, and a recommendation would be to agree on the scope of service and document the scope of service. Again, the specification at page 11, line 20 through page 12, line provides still additional enablement of how results of the matrix and results of the questions may be combined to provide recommendations: “[a] comparison of the ‘now’ results with the ‘goal’ for each service attribute [obtained through questions and recorded on the matrix] can lead quite easily to conclusions about areas for improvement (where the now level of service is less than the goal level of service) as well as areas for possible economy (where the now level of service in column 510 exceeds the goal level of service in column 520).” Thus, the specification provides that by asking questions, one can determine the level of maturity; i.e., the specification shows a direct and explicit connection between the questions and the matrix that enable one of ordinary skill in the art to make recommendations.

The Examiner further stated that it was not clear how the matrix indicates customer satisfaction since there is no description of the how the matrix is utilized. Utilization of the assessment tools is described in the specification on page 9, lines 13-16 which state that the matrix (one of the assessment tools) may be used in one of several engagement approaches or types of analyses such as a quick, general assessment, a medium depth assessment, an in-depth, interview-based assessment, and an in-depth, workshop-based assessment. *See* also the specification at page 6, line 14 through page 7, line 2. Thus, one of skill in the art of IT is taught the types of assessment techniques, how to administer the assessment techniques, and how the results captured in the matrices measure customer satisfaction, and then depending upon the results shown in the matrices, whether to recommend that a particular service attribute be improved or that the service be cut back for economies of scale. In addition, the specification at page

13, lines 8 through 14 states how services are assessed using the selected technique and that the information may be captured through various techniques. Matrices may be more suitable in workshops; questions may be asked. Respectfully, the specification does teach one of ordinary skill in the art of information technology how to utilize a matrix as presented and, in light of the specification, the claims particularly point out and distinctly claim the subject matter of the invention thus satisfying the requirements of both paragraphs of 35 U.S.C. §112.

The Examiner states that “[o]ne of ordinary skill in the art would not be able to make and or use the claimed invention in a way that would produce a repeatable result. Respectfully, the Examiner is in error when she applies the test of repeatability for enablement. Whether the results of the claimed system or method are repeatable is not and has never been an inquiry of whether a claimed invention is enabled, especially given the situation as here. In fields such as information technology wherein the claimed invention assesses a customer’s **perception** of the quality of information technology services, a customer’s perception will change not only from customer to customer but also from day to day, hour to hour, etc., but will also change from service attribute to service attribute. Part of the beauty of the claimed invention is the flexibility with which the system and method can accommodate different customers at different times and at different services.

*The Rejection of claims 1-9 and 13-19 under 35 U.S.C. §112, 2<sup>nd</sup> ¶*

The Examiner rejected claims 1-9 and 13-19 because it was not clear how each row can correspond to both an attribute and a maturity level. And if all rows contain both attributes and maturity levels, how can the matrix provide an indication of customer satisfaction; and if all rows pertain to the same attribute or if each row represents each of the attributes. In response, Applicants have amended the claim and now claim that along one axis, the columns, are the levels of maturity of the information technology service attribute; and along the other axis, the rows, is the particular information technology service attribute. In amending the claim, Applicants are further asserting that the claims cover the situation wherein the rows will indicate the level of maturity and the columns will indicate a particular service attribute. Respectfully,

Applicants request the Examiner withdraw the rejection of claims as being indefinite under 35 U.S.C. §112, 2<sup>nd</sup> ¶ in view of the amendments.

*The Rejection of claims 1-9 and 13-19 under 35 U.S.C. §101*

The Examiner also rejected the claims 1-9 and 13-19 under 35 U.S.C. §101 as directed to non-statutory subject matter that allegedly does not produce a useful, concrete and tangible result. The Examiner asserts that there is no description of how the matrix provides an indication of a customer's satisfaction. The Examiner further asserts that there is no description of how one combines the results from the matrix and the questions to make recommendations. The Examiner states that the claimed invention is not concrete and not useful because one would not know how to make recommendations because there are no set guidelines to correlate with evaluation outcome in a way that would produce a repeatable result. The Examiner further asserts that the determination of IT maturity is not concrete and does not produce a useful result.

Applicants respectfully traverse and refer the Examiner to the discussion of the claims under 35 U.S.C. §112 above. Attorney for Applicants, moreover, have reviewed the U.S. Patent Office's Interim Guidelines for Examination of Patent applications for Patent Subject Matter Eligibility published in the Official Gazette on 22 November 2005, and Ex parte Carl A. Lundgren, Appeal No. 2003-2088, Application 08/093,516 at <http://www.uspto.gov/web/offices/dcom/bpai/prec/2003-2088.pdf>, and Metabolite Laboratories, Inc. v. Laboratory Corp. of American Holdings, Appeal No. 03-1120 (Fed. Cir. June 8, 2004). Applicants continue to traverse the rejection by pointing that the claimed invention as a whole is useful, accomplishes a practical application, and produces a useful, tangible and concrete result in the art of providing information technology services; and that the claimed invention is not an abstract idea, nor a law of nature, nor a natural phenomena.

Applicants direct the Examiner's attention to page 10, lines 17-19 which provides an example of a useful, concrete, and tangible result, i.e., the claimed process "determines whether the provider and the customer have a common understanding of the scope and objective of the IT service being provided and to identify any disparity

between the expectations.” In the art of Information Technology, this is a very useful, concrete, and tangible result. Applicants further direct the Examiner’s attention to page 11, lines 9-14 which state that “[t]he answers to these questions will lead the assessment to a determination of the level of maturity as well as identifying areas for improvement. For instance, if there is a disagreement on the scope of the service between the provider and the customer, it will be hard to have a mature service and the remedy suggested may be that the provider and the customer agree on the scope of the service and document it. One key aspect to assessing a service is to note the gap between the reality and the perceptions as seen by the customer and by the provider.” In the art of information technology services, not much more can be tangible and useful to a customer and provider than knowing that there is an agreement or a misunderstanding regarding the delivery of information technology services. Another example of a tangible, useful, and concrete result provided by the claimed invention is that a “comparison of the ‘now’ results with the ‘goal’ for each service attribute can lead quite easily to **conclusions about areas for improvement** (where the now level of service is less than the goal level of service) as well as **areas for possible economy** (where the now level of service in column 510 exceeds the goal level of service in column 520)”, specification at page 11, line 20 through page 12, line 1 (emphasis added). The claimed invention also provides that “the objectives of the IT organization in delivering its services may become better aligned with the objective of the organization as a whole.” See specification at page 12, lines 3-4. Certainly, identifying economies of scale and areas for improvement, aligning the delivery of services with the objectives of the organization are real, tangible, and useful consequences in the art of information technology when using the claimed system and method of the invention.

Applicants thus respectfully request the Examiner to reconsider the rejection of the claims under 35 U.S.C. §101 as not reciting statutory subject matter. The procurement of information through the use of particular and detailed questions of a particular focus area unique to the field of information technology and to the customer and the provider of these services along with descriptions, considerations, and an example of the service attribute to determine the level of maturity of information service attributes represented on a simple or detailed matrix to assess a customer’s satisfaction

with information technology services and recommend changes to provide a more or less mature level of service is concrete in the world of information technology, certainly is useful, and certainly is tangible.

Quite simply, the Examiner is in error when she applies the test for usefulness and practicable application of a claimed invention as being whether the results are repeatable; whether the results are repeatable is not and has never been the sole test of whether a claimed invention has a practicable application. In fields such as information technology wherein the claimed invention is said to assess a customer's **perception** of the quality of information technology services, a customer's perception will change not only from customer to customer but also from day to day, hour to hour, etc. Therein lies one aspect of the usefulness, tangible, concrete, and most of all, practical application of the invention: to measure how a customer's perception can change.

What is repeatable and concrete, moreover, is that once a customer's perceptions of an information technology service attribute are assessed using the questions, whether simple or detailed questions, and once a the maturity of an information technology service attribute is rated, then for every event in which the a customer's perceptions of the maturity do not meet the actual level of maturity, there is a need for a recommendation depending upon the service attribute. That much, for sure, is repeatable and is concrete, i.e., determining if there is a need for recommendations.

*The Rejection of claims 1-9 and 13-19 under 35 U.S.C. §103(a)*

The Examiner further rejected claims 1-9 and 13-19 under 35 U.S.C. §103(a) as being unpatentable over Daskalantonakis over CMM. The Examiner asserts that Daskalantonakis teaches an assessment matrix, as well as a set of questions to assess processes and then using the assessments to identify weak areas for attention and improvement. The Examiner combines Daskalantonakis with CMM wherein CMM teaches a capability maturity model having levels of initial (ad hoc), repeatable, defined (consistent), managed (exceptional), and optimizing (world class).

Applicants respectfully traverse because both references deal only with the realm and process of software development and software engineering, there is no mention or hint of applicability of evaluating a customer's perception of information technology

services. As an additional basis for the traversal of the rejection, both references teach that their systems and methodologies are used internally in a software engineering environment. Daskalantonakis teaches a methodology “as an internal tool to help organizations prepare for a formal SEI [Software Engineering Institute] assessment.” (Emphasis added) The SEI assessment is set forth in the CMM reference. At page 27 of the CMM reference, four uses are supported by the CMM, all of which are internally directed: assessment teams to identify strengths and weaknesses in the organization; evaluation teams to identify risk of selecting different contractors for awarding business and monitor contracts; managers and technical staff to plant and implement a software process improvement program for their organization; and process improvement groups to define and improve the software process in their organization. Thus, neither reference suggests monitoring customer satisfaction with an end product in the information technology industry.

In fact, Applicants specifically teach against the approach used by Daskalantonakis and CMM: in the specification at page 4, Applicants state:

One approach to evaluating the effectiveness of an IT operation is to focus on the processes and procedures which are employed by the IT operation itself. This is sometimes referred to as a production method, since it focuses on the production of IT deliverables in assessing the effectiveness and the adequacy of the IT operations. [describing CMM and Daskalantonakis exactly] This is also an inwardly aligned evaluation [that] does assess in evaluating the efficiency of the IT infrastructure by aligning the goals and initiatives across the enterprise’s processes. It allows an emphasis on repeatability, consistency and robust process execution across an enterprise.

However, process assessment (looking at the processes used in the IT organization may be a useful indicator of IT effectiveness but it is not as good an indicator of the satisfaction and value as perceived by the users of the IT services (the external customers who are using the IT services being provided by the IT organization). Page 4, lines 1-11.

....

The present invention has the advantage that it focuses on the perception of the customers in evaluating the effectiveness of the IT delivery system and is therefor sometimes characterized as an evaluation of the delivery or outward manifestation of the IT system rather than an inward evaluation of the production system. Page 5, lines 16-19. (Emphasis added)



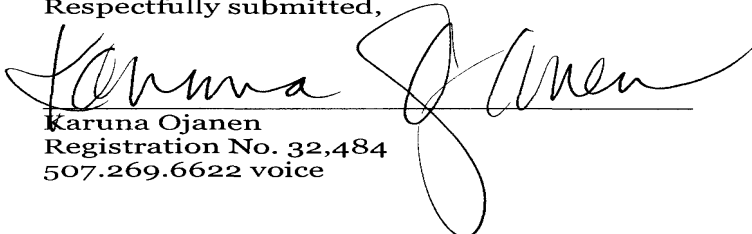
Conclusion

Having thus amended the claims to remove any indefiniteness of the claims and by pointing out the support in the specification that enable one of ordinary skill in the art to make and use the invention, Applicants have overcome the rejection of the claims under 35 U.S.C. §112, first and second paragraphs. Applicants have further traversed the rejection of the claims under 35 U.S.C. §101 by pointing out how the claimed invention as described in the specification does provide concrete, useful, and tangible results in the world of information technology services. Applicants have further argued that the references used by the Examiner to support a rejection of the claims under 35 U.S.C. §103(a) teach an inwardly-focused process improvement for software engineering, which teaches against an outwardly-focused evaluation of customer satisfaction of information technology services. Applicants request the Examiner to allow all claims. The Examiner is further invited to telephone the Attorney listed below if she thinks it would expedite the prosecution and the issuance of the patent.

Respectfully submitted,

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